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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicant: | Beth N. Grijalva | § | Group Art Unit: | 3764 |
| Serial No.: | 09/594,445 | § | | |
| | | § | Examiner: | L. Hamilton |
| Filed: | June 15, 2000 | § | | |
| For: | Eye Patch | § | Atty. Dkt. No.: | GRIJ.0002-US |

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF TRANSMITTAL

Dear Sir:

Transmitted herewith in triplicate is the Appeal Brief in this application. The Notice of Appeal was filed on February 26, 2003.

Pursuant to M.P.E.P. § 1208.02, there is no fee due for this Appeal, because the Examiner reopened prosecution after filing of the first Appeal Brief on December 31, 2001. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (GIJ.0002US).

Adjustment date: 07/16/2003 SDIRETA2
05/29/2003 SWILLIAM 00000001 201504 09594445
01 FC:2402 160.00 CR

Respectfully submitted,

Date: May 5, 2003

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Date of Deposit: May 2, 2003
I hereby certify under 37 CFR 1.8(a) that this correspondence is being deposited with the United States Postal Service as **first class mail** with sufficient postage on the date indicated above and is addressed to the Board of Patent Appeal & Interferences, Commissioner for Patents, Washington, DC 20231.

Janice Munoz

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APPEAL BRIEF

Dear Sir:

Applicant hereby appeals from the Final Rejection dated November 27, 2002.



## I. REAL PARTY IN INTEREST

The real party in interest is the inventor, Beth N. Grijalva.

## II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

## III. STATUS OF THE CLAIMS

The application was originally filed with claims 1-38. Claims 39-56 have been added by amendment. Claims 1-56 have been finally rejected and are the subject of this Appeal.



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## IV. STATUS OF AMENDMENTS

An Amendment (copy enclosed) is being filed concurrently herewith to correct a typographical error in claim 46. It is assumed for purposes of the Appeal that the Amendment will be entered, as the Amendment further narrows down the issues on appeal. There are no other unentered amendments.

## V. SUMMARY OF THE INVENTION

Referring to Figs. 1 and 2, an embodiment 10 of an assembly in accordance with the invention includes a flexible eye patch 20 that is fastened to the front of a pair of eyeglasses 50 for purposes of blocking both the frontal and peripheral vision of an eye of a wearer of the eyeglasses 50. The blockage of the eye's vision may be used for purposes of strengthening the other eye, for example, to adjust the relative strengths of the wearer's eyes. Specification, p. 3.

More specifically, in some embodiments of the invention, the eye patch 20 includes a substantially opaque and elongated flexible body 21 that is attached to eyeglass frames 59 of the eyeglasses 50 by at least two fasteners 22 (Fig. 2), and 32 (Fig. 1). The body 21 may be made from one or more layers of fabric that are singularly or collectively substantially opaque. The fabric may be, as examples, cloth or foam. When the body 21 is formed from multiple layers, these multiple layers may be laminated together by a fusible web or an adhesive, as just a few examples. Specification, p. 3.

The fastener 22 (see Fig. 2), attaches one end of the body 21 to a side arm 56 (a left side arm 56a, for example), of the frames 59 approximately near the temple of the wearer, and the other fastener 32 attaches the other end of the body 21 to a bridge 54 of the frames 59. In this manner, when the eye patch 20 is fastened to the front of frames 59, the body 21 extends over a lens socket 52 (a left lens socket 52a, for example), of the frames 59 and extends around the side

of the frame s 59 to block both frontal and peripheral vision through the lens socket 52. Specification, p. 3.

As depicted in Figs. 1 and 2, the eye patch 20 extends around the left lens socket 52a (where the left/right orientation is with respect to the wearer of the eyeglasses 50). However, the eye patch 20 may alternatively extend over the right lens socket 52b, in other embodiments of the invention. In addition to the fasteners 22 and 32, the eye patch 20 may include additional fasteners, such as a fastener 34 (Fig. 2) to provide an attachment point closer to the left lens socket 52a than the attachment point that is provided by the fastener 22. Specification, p. 3.

In the context of this application, the front of the eyeglasses 50 refers to the side (of the eyeglasses 50) that receives incident light from viewed objects when the pair of eyeglasses 50 is being worn. The rear of the eyeglasses 50 refers to the other side (of the eyeglasses 50) that is in close proximity to the face of the wearer. Although the pair eyeglasses 50 in the figures is depicted as including lens 30 that are inserted into the lens sockets 52a and 52b, one or both lens 30 may not be present in some embodiments of the invention. Specification, pp. 3-4.

The above-described arrangement may offer one or more of the following advantages. The eye patch 20 connects to the bridge 54, a feature common to all eyeglasses. In contrast, eye patches that connect to the inside of the frame via the nose pad may not be used in cases where nose pads are not present on the frames, such as plastic frames that are worn by many children, for example. Also, newer frames may have nose pads that are either molded into the frame or made in a continuous piece that does not permit attachment of the eye patch to the nose pad. Attachment of the patch to the bridge provides less risk of damaging the frames 59 when attaching or removing the eye patch 20. In this manner, many nose pads are attached using a wire that is soldered to or otherwise made a part of the frame itself, and the nose pads are not

intended to bear stresses significantly greater than the weight of the eyeglasses resting on the wearer's nose. An individual, especially a child, could easily snap off a nose pad of this type in repeated applications and removals, thereby requiring replacement of the frames. Specification, p. 4.

Connecting the eye patch 20 to the bridge 54 and fitting the eye patch over the lens socket 52 rather than around the lens socket 52 permits the eye patch 20 to fit a wide variety of sizes and shapes of lenses. Furthermore, fitting the eye patch 20 on the outside of the lens 30 rather than inside or inside and outside of the lens socket 52 provides a greater degree of comfort, making it more likely the wearer (especially when a child is the wearer), will find it easier to adapt to wearing the eye patch 20 and actually use it. Specification, p. 4.

Attaching the eye patch 20 to the front of the frames 59 also gives better air circulation, less dampness and less potential irritation or infection of the skin or eye by the eye patch 20, moisture, dirt or by any detergents or cleaners used to launder the eye patch 20. Additionally, connecting the eye patch 20 to the front of the frames 59 means that the eye lashes and eye are not irritated by contact or rubbing. Specification, p. 4.

The absence of an adhesive to attach the eye patch 20 directly to the face of the wearer prevents irritation of the skin and eyebrow from daily or more frequent application and removal, both from pulling and from sensitivities or allergies to the adhesive. Specification, p. 4.

Because the eye patch 20 is attached to the front of the frames 59, the fabric of the body 21 may incorporate decorative designs and fabrics that are appealing to children and adults. In addition to keeping the eye patch 20 from rubbing or irritating the eye, attachment at the bridge 54 near the temple corner gives a greater stability in the fit that is especially important for active children. The eye patch 20 may be adapted (as described below) to form a universal patch that

may be used on either the left or right eye. Durable materials may be used to form all parts of the eye patch 20, thereby allowing some form of cleaning and disinfecting of the eye patch 20 for repeated wearing. Specification, pp. 4-5.

Other and different advantages than those that are stated above are possible in the various embodiments of the invention. Specification, p. 5.

Fig. 3 depicts a rear view of the eyeglasses 50. As shown, the fastener 32 includes a fabric loop 33 (a loop that is formed from a material that is sewn to the body 21, for example), that extends around the bridge 54 to secure the eye patch 20 to the front of the frames 59. The free end of the loop 33 is connected via a snap connector 35 to the body 21 to form a releasable connection that permits the fastener 32 to be attached to and removed from the bridge 54. Referring also to Figs. 4 and 5, one end of the loop 33 is secured (sewn to, for example), to the body 21. The free end of the loop 33 includes one part 43 of the snap connector 35, with another mating part 44 of the snap connector 35 being secured to the body 21. The part 44 that is secured to the body 21 is positioned to allow sufficient slack in the loop 33 to permit the loop 33 to extend around the bridge 54 of the frames 59. Specification, p. 5.

The fasteners 22 and 34 form loops around the side arm 56. In some embodiments of the invention, the fastener 22 includes a fabric loop 40 that has one end that is secured to the end of the body 21 opposite from the end of the body 21 that is attached to the fastener 32. The other free end of the loop 40 includes one part 46 of a snap connector 41 (see also Fig. 2), with another mating part 45 of the snap connector 41 being secured to the fabric body 21. The part 45 of the snap connector 41 is positioned to allow sufficient slack in the loop 40 to permit the loop 40 to extend around the left side arm 56a and to properly position the eye patch 20 on the frames 59. Specification, p. 5.

The fastener 34, in some embodiments of the invention, is positioned approximately midway between the fasteners 22 and 32 on the body 20 to form an attachment point to the left side arm 56a near the left lens socket 52a. The fastener 34 includes a fabric loop 38 that has both of its ends attached together to the body 21. Therefore, the fastener 34 is essentially a permanent loop through which the left side arm 56a slides when the eye patch 20 is mounted on the frames 59. In some embodiments of the invention, the fabric loop 38 may be formed from an elastic material. Specification, pp. 5-6.

The fasteners 22, 32 and 34 are positioned on the body 21 to properly position the body 21 over the left lens socket 52a (see Fig. 1) and around the side of the frames 59 (see Fig. 2). For the example of the eye patch 20 that is depicted in Fig. 5, the fastener 22 is slightly higher than the fastener 32 to accommodate mounting the eye patch 20 over the left lens socket 52a. Specification, p. 6.

Referring to Fig. 4, in some embodiments of the invention, the eye patch 20 may be generally cup-shaped for purposes of providing a contoured fit around the frames 59. The contoured shaped may be due to one or more darts 23 (one dart 23 is depicted in Fig. 5) that are formed in the body 21 near the lower part of the body 21. The term "dart" generally refers to feature that is created by a sewing technique in which a wedge-shaped piece of the body 21 is removed, and afterwards, the fabric that surrounds the region where the piece is removed is sewn together in a seam to impart the cup-shaped form to the body 21. Specification, p. 6.

Other embodiments are within the scope of the following claims. For example, Figs 6 (a top view) and 7 (rear view) depict a left eye patch 100 that may be used in place of the eye patch 20. The eye patch 100 has similar features to the eye patch 20, with the differences being pointed out below. In particular, for the eye patch 100, the fastener 22 (of the eye patch 20) is

replaced by a fastener 110. The fastener 110 includes a fabric loop 111 that is attached (sewn to, for example) at its two ends to a body 101 of the eye patch 100. In this manner, the left side arm 56a of the frames 59 slides through the loop 111 to attach one end of the body 101 to the frames 59. Another difference between the two eye patches 20 and 100 is the presence of two darts 114 and 116 (as compared to the one dart 23 that is depicted for the eye patch 20) at the top and bottom of the eye patch 100 to increase the contoured fit of the eye patch 100 with the frames 59. Specification, p. 6.

As another example, Fig. 8 depicts a right eye patch 150 that includes a fastener 157 for attaching one end of a flexible body 151 (of the eye patch 150) to the right arm 56b of the frames 59. Unlike the fasteners that are described above, the fastener 157 does not include a fabric loop that is formed from a piece of material that is separate from the body 151. Instead, the fastener 157 is formed from two parallel slits 158 that are formed in the body 151. In this manner, the right side arm 56b may be threaded through the slits 158 so that the fabric (of the body 151) that bridges the slits 158 holds the body 151 to the frames 59. A fastener 152 attaches the body 151 to the bridge 54. The fastener 152 may also be formed from the fabric that forms the body 151. In this manner, the body 151 has an extension 155 that forms a loop for extending around the bridge 54 to secure the other end of the body 151 to the frames 59. The far end of the extension 155 has a snap connector part 154 that mates with a complementary snap connector part 156 that is secured to the body 151 to form a releasable snap connector for attaching the eye patch 150 to the bridge 54. Specification, pp. 6-7.

Referring to Fig. 9, in another embodiment of the invention, a left eye patch 200 includes a fastener 211 that is formed from slits 210 in a fabric body 201 (of the eye patch 200) for attaching the left side arm 56a of the frames 59 to one end of the body 201 similar to the fastener

157 that is formed from the slits 158, described above. The eye patch 200 also includes a fastener 202 for attaching the other end of the body 201 to the bridge 54. Unlike the fasteners that are described above, the fastener 202 includes an extension 206 with an arrowhead 208 formed at the tip of the extension 206. The arrowhead 208 may be inserted into a slot 204 (of the fastener 202) that is formed in the body 201. In this manner, when the arrowhead 208 is inserted into the slot 204, the extension 206 loops around the bridge 54, and the prongs of the arrowhead 208 extend beyond the front surface of the body 201 to releasably secure the arrowhead 208 to the body 201. Specification, p. 7.

In yet another embodiment of the invention, Fig. 10 depicts a left eye patch 230 that includes a fastener 233 similar in design to the fastener 152 (see Fig. 8). In this manner, the fastener 233 includes an extension 236 from one end of a flexible body 231 (of the eye patch 230) to extend around the bridge 54. The free end of the fastener 233 includes a snap connector part 238 that mates with another snap connector part 234 that is attached to the body 231 to form a snap connection. The eye patch 230 also includes a connector 237 that is formed from two parallel slits 235 that receive the left side arm 56a that is threaded therethrough to attach the eye patch 230 to the left arm 56. It is noted that the slits 235 of the fastener 237 may be located farther apart than the slits 210 of the fastener 233. Specification, p. 7.

The eye patches depicted above are for use with either the left or right eye. However, universal eye patches are within the scope of the claims. For example, Fig. 11 depicts a universal eye patch 240 that may be used to block frontal and peripheral vision of either the left or right eye. In this manner, the eye patch 240 includes a fastener 244 for attaching the eye patch 240 to the bridge 54. This fastener 244 includes an extension 245 (of a body 241 of the eye patch 240) that extends from one end of the body 241 around the bridge 54. One end of the

extension 245 includes a part 246 that mates with another part 248 that is attached to the body 241 to form a snap connection. Unlike similar fasteners that are described above, the fastener 244 may be used to attach the eye patch 240 to the bridge 54 regardless of whether the eye patch 240 covers the right or left eye. To accomplish this, the attached snap connector part 248 is located near the vertical midway point of the body 241 to permit its use regardless of the orientation of the eye patch 240. Specification, pp. 7-8.

The eye patch 240 includes two fasteners 249 and 251 to attach the eye patch 240 to the arm 56. More specifically, the fastener 249 is for the right eye configuration and includes two parallel slits 242 that are located near the top of the body 241 for the right eye configuration (depicted in Fig. 11) for purposes of attaching the eye patch 240 to the right side arm 56b. In this right eye configuration, two parallel slits 243 of the fastener 251 are formed in the body 241 near the bottom of the body 241. However, the fastener 251 is used for the left eye configuration. Therefore, when the eye patch 240 is flipped over to place the eye patch 240 in the left eye configuration, the slits 243 are located near the top of the body 241 in the proper position to attach the eye patch 240 to the left side arm 56a. Specification, p. 8.

## VI. ISSUES

**A. Can a reference that does not teach all of the limitations of independent claim 1 anticipate claims 1-11 and 13-15 and render claim 12 obvious?**

**B. Can a reference that does not teach all of the limitations of independent claim 16 anticipate claims 16-25 and 27-29 and render claim 26 obvious?**

**C. Can a reference that does not teach all of the limitations of independent claim 30 anticipate claim 30-33?**

**D. Can a reference that does not teach all of the limitations of independent claim 34 anticipate claims 34-38?**

**E. Can a reference that does not teach all of the limitations of independent claim 39 anticipate claims 39-41 and 43-45 and render claim 42 obvious?**

**F. Can a reference that does not teach all of the limitations of independent claim 46 anticipate claims 46-48 and render claims 49-51 obvious?**

**G. Can a reference that does not teach all of the limitations of independent claim 52 anticipate claims 52-56?**

**H. Can claims 2 and 3 be indefinite when these claims satisfy the requirements of 35 U.S.C. § 112, second paragraph?**

**I. Can claims 31 and 33 be indefinite when these claims satisfy the requirements of 35 U.S.C. § 112, second paragraph?**

## VII. GROUPING OF THE CLAIMS

Claims 1 and 4-15 can be grouped together; claims 2 and 3 can be grouped together; claims 16-29 can be grouped together; claims 30 and 32 can be grouped together; claims 31 and 33 can be grouped together; claims 34-38 can be grouped together; claims 39-45 can be grouped together; claims 46-51 can be grouped together; and claims 52-56 can be grouped together. With this grouping, all claims of a particular group stand or fall together. Furthermore, regardless of the grouping set forth by the Examiner's rejections, the claims of each group set forth in this section stand alone with respect to the other groups. In other words, any claim of a particular group set forth in this section does not stand or fall together with any claim of any other group set forth in this section.

## VIII. ARGUMENT

All claims should be allowed over the cited references for the reasons set forth below.

**A. Can a reference that does not teach all of the limitations of independent claim 1 anticipate claims 1-11 and 13-15 and render claim 12 obvious?**

The eye patch of independent claim 1 is usable with eyeglass frames that includes a bridge and a side arm. The eye patch includes a flexible body to be positioned on a front of the frames to substantially block both frontal and peripheral vision of an eye. The eye patch also

includes a first fastener to attach the body to the bridge and a second fastener to attach the body to the side arm.

The Examiner rejects independent claim 1 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,310,077 (hereinafter referred to as "Heaford"). Heaford generally teaches an arrangement to convert an ordinary pair of glasses into a pair of sunglasses. More specifically, Heaford describes an "eye protector" to "seal the eyes from the glare of lights." Heaford, ll. 12-14, p. 1. Furthermore, Heaford discloses that the eye protector is formed from "celluloid, or other suitable material of any suitable color to effect the desired softening of the light." *Id.*, ll. 44-47, p. 1. Thus, Heaford is generally directed to a material that is placed over a pair of glasses for purposes of reducing light glare.

However, claim 1 specifically recites that the flexible body substantially blocks both frontal and peripheral vision of an eye. In contrast, Heaford's eye protector is directed to softening light, not substantially blocking vision. Thus, Heaford fails to teach or even suggest the limitations of independent claim 1.

The Examiner contends that the claim language "to block both frontal and peripheral vision of an eye" is language that sets forth an "intended use" and therefore refuses to assign any patentable weight to this language. Final Office Action, 4. Therefore, in effect, the Examiner is reducing claim 1 to a mere collection of parts, i.e., a flexible body, a first fastener and a second fastener.

Contrary to the Examiner's construction of independent claim 1, the Federal Circuit has stated it is improper to delete functional language from a claim in performing an invalidity determination under Section 102. *Pac-tec, Inc. v. Amerace Corporation*, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990). The *Pac-tec* court rejected a construction of claims that are eliminated as

functional limitations so that the claims were reduced to a mere collection of parts. *Id.* That is exactly what the Examiner is attempting to do, namely, ignore specific recitation of elements in independent claim 1 so that claim 1 is in effect a collection of parts. The alleged "intended use" language of claim 1 describes a property of the flexible body (i.e., sets forth that the body substantially blocks vision) and interrelates the flexible body to the other elements of claim 1 to therefore define the structure of the flexible body. *See, In re Venezia,* 189 USPQ 149, 151-152 (CCPA 1976) (stating "there is nothing wrong in defining the structures of the components . . . in terms of the interrelationship of the components").

Therefore, when the language of independent claim 1 is properly construed and expressly recited words of claim 1 are given the weight that they are due, Heaford does not teach or even suggest all of the limitations of independent claim 1. Claims 2-15 are patentable for at least the reason that these claims depend from an allowable claim.

Thus, for at least the reasons set forth above, the §§ 102 and 103 rejections of claims 1-15 are improper and should be reversed.

**B. Can a reference that does not teach all of the limitations of independent claim 16 anticipate claims 16-25 and 27-29 and render claim 26 obvious?**

The assembly of independent claim 16 includes eyeglass frames and an eye patch. The eyeglass frames include a bridge and a side arm. The eye patch includes a flexible body, a first fastener and a second fastener. The flexible body is positioned on a front of the frames to substantially block both frontal and peripheral vision of an eye. The first fastener attaches the body to the bridge of the eyeglass frames, and the second fastener attaches the body to the side arm of the eyeglass frames.

The Examiner rejects claim 16 under 35 U.S.C. § 102(b) as being anticipated by Heaford. However, Heaford does not teach or even suggest a flexible body to be positioned on the front of the frames of eyeglasses to substantially block both frontal and peripheral vision of an eye. Instead, Heaford is generally directed to a type of sun shade to block glare from light.

The Examiner refuses to assign any patentable weight to the language, "to be positioned on a front of the frames to substantially block both frontal and peripheral vision of an eye" because the Examiner contends that language merely recites "an alleged intended use." Final Office Action, 4. However, with construction, the Examiner is effectively reducing independent claim 16 to a mere collection of parts.

The alleged "intended use" language of independent claim 16 defines an interrelation between the flexible body and the other elements of claim 16 and sets forth the light block property of the flexible body. Therefore, the language that is being ignored by the Examiner defines the structure of the flexible body. As such, it is improper to ignore these limitations. When the language of independent claim 16 is properly construed and expressly recited words of the claim are given the weight that they are due, Heaford neither teaches nor suggests all of the limitations of independent claim 16. Claims 17-29 are patentable for at least the reason that these claims depend from an allowable claim.

Thus, for at least the reasons stated above, the §§ 102 and 103 rejections of claims 16-29 are improper and should be reversed.

**C. Can a reference that does not teach all of the limitations of independent claim 30 anticipate claim 30-33?**

The eye patch of independent claim 30 is usable with eyeglass frames and includes a flexible body and at least one fastener. The flexible body is to be fastened to at least partially

cover a front of the eyeglass frames to substantially block both frontal and peripheral vision of an eye, and the fastener secures the flexible body to the frames.

The Examiner rejects independent claim 30 under 35 U.S.C. § 102(b) as being anticipated by Heaford. Heaford, however, neither teaches nor suggests the flexible body of claim 30. The Examiner, in effect, is ignoring the specific claim limitations of independent claim 30 under the guise that the limitations are an "intended use." However, when these limitations are given their proper weight, Heaford neither teaches nor suggests all of the limitations of independent claim 30. More specifically, Heaford neither teaches nor suggests a body to block either frontal or peripheral vision. Claims 31-33 are patentable for at least the reason that these claims depend from allowable claim.

Thus, for at least the reasons stated above, the § 102 rejections of claims 30-33 are improper and should be reversed.

**D. Can a reference that does not teach all of the limitations of independent claim 34 anticipate claims 34-38?**

The assembly of independent claim 34 includes eyeglass frames and an eye patch that includes a flexible body. The flexible body is to be fastened to at least partially cover a front of the eyeglass frames to substantially block both frontal and peripheral vision of an eye.

The Examiner rejects independent claim 34 under 35 U.S.C. § 102(b) as being anticipated by Heaford. However, Heaford neither teaches nor suggests a flexible body that substantially blocks both frontal and peripheral vision of an eye. To arrive at the conclusion that Heaford anticipates claim 34, the Examiner ignores limitations of claim 34 to reduce claim 34 to a mere collection of parts, i.e., a flexible body and at least one fastener. However, ignoring these claim limitations is improper, as the language that describes a flexible body defines the light block

property of the body and the interrelationship of the body with other components. Therefore, patentable weight should be assigned to the language that has not been given patentable weight by the Examiner.

Because Heaford does not teach all of the limitations of claim 34 when the expressly recited limitations are given the patentable weight that they are due, Heaford fails to teach all limitations of independent claim 34. Claims 35-38 are patentable for at least the reason that these claims depend from an allowable claim.

Thus, for at least the reasons stated above, the § 102 rejections of claims 34-38 are improper and should be reversed.

**E. Can a reference that does not teach all of the limitations of independent claim 39 anticipate claims 39-41 and 43-45 and render claim 42 obvious?**

The eye patch of claim 39 is usable with eyeglass frames that include a bridge. The eye patch includes a flexible body to be positioned on the front of the frames to substantially block both frontal and peripheral vision of an eye. The eye patch also includes a fastener that extends from the body to attach the body to the bridge.

The Examiner rejects independent claim 39 under 35 U.S.C. § 102(b) as being anticipated by Heaford. However, Heaford neither teaches nor suggests a flexible body to substantially block vision of an eye, whether frontal or peripheral vision. The Examiner refuses to consider expressly recited limitations that define the flexible body, as the Examiner contends these limitations are an "intended use." However, the Examiner's refusal to consider these claim limitations is improper, as these limitations define the structure of the flexible body by defining a property of the body and the interrelationship of the body to other components. Thus, when the expressly recited limitations of claim 39 are given the patentable weight that they are due,

Heaford does not teach or even suggest the limitations of independent claim 39. Claims 40-45 are patentable for at least the reason that these claims depend from an allowable claim.

Thus, for at least the reasons stated above, the §§ 102 and 103 rejections of claims 39-45 are improper and should be reversed.

**F. Can a reference that does not teach all of the limitations of independent claim 46 anticipate claims 46-48 and render claims 49-51 obvious?**

The eye patch of independent claim 46 includes a flexible body, a first fastener and a second fastener. The flexible body includes a first portion that is positioned on a front of the frames to substantially block frontal vision of an eye. The flexible body also includes a second portion that is attached to the first portion to substantially block peripheral vision of the eye. The eye patch includes a first fastener to attach the body to the bridge and a second fastener to attach the body to the side arm.

The Examiner rejects independent claim 46 under 35 U.S.C. § 102(b) as being unpatentable in view of U.S. Patent No. 4,582,401 (hereinafter referred to as "Grindle"). Grindle generally teaches a lens occluder to block frontal vision of a particular eye. However, Grindle does not teach or even suggest a flexible body having a second portion to substantially block peripheral vision of an eye.

To teach the second portion of claim 46, the Examiner refers to lines 4-6 in column 2 of Grindle. However, the cited language states an object of the invention and does not teach or even suggest such a second portion to block peripheral vision. The Examiner is refusing to assign any patentable weight to the language, "a second portion attached to the first portion to substantially block peripheral vision of the eye." However, the Examiner's refusal to assign patentable weight is clearly improper, as this language defines another portion of the flexible

body, defines a property of the flexible body and therefore, defines part of the structure of the body.

Therefore, when the language of claim 46 is given the patentable weight that it is due, Grindle does not anticipate claim 46. Claims 47-50 are patentable for at least the reason that these claims depend from an allowable claim.

Thus, for at least the reasons set forth above, the §§ 102 and 103 rejections of claims 46-50 are improper and should be reversed.

**G. Can a reference that does not teach all of the limitations of independent claim 52 anticipate claims 52-56?**

The method of independent claim 52 includes providing a flexible body to attach to a front of eyeglass frames to substantially block both frontal and peripheral vision of an eye. The method also includes providing a first fastener to attach the body to a bridge of eye glass frames and providing a second fastener to attach the body to a side arm of the eyeglass frames.

The Examiner rejects independent claim 52 under 35 U.S.C. § 102(b) as being anticipated by Grindle. However, Grindle neither teaches nor suggests providing a flexible body to attach to a front of eyeglass frames to substantially block both frontal and peripheral vision. Thus, once again, the Examiner refuses to assign any patentable weight to certain language. It is not clear why the Examiner is refusing to assign any patentable weight, as the Examiner does not specifically address the limitations of claim 52. However, when the limitations of claim 52 are given the patentable weight that they are due, Grindle neither teaches nor suggests the limitations of claim 52. Claims 53-56 are patentable for at least the reason that these claims depend from an allowable claim.

Thus, for at least the reasons stated above, the § 102 rejections of claims 52-56 are improper and should be reversed.

**H. Can claims 2 and 3 be indefinite when these claims satisfy the requirements of 35 U.S.C. § 112, second paragraph?**

The eye patch of claim 2 depends from claim 1 and recites that the body of claim 1 is adapted to at least partially extend over a lens socket of the eyeglass frames. Claim 3 depends from claim 1 and recites that the body of claim 1 is adapted to at least partially extend over a lens of the eyeglass frames.

The Examiner rejects claims 2 and 3 under the second paragraph of 35 U.S.C. § 112. In this rejection, the Examiner states, "merely claiming that the eye patch 'usable with eyeglass frames' does not means that the eyeglass frames have been positively recited." Final Office Action, 2.

The Examiner fails to set forth a proper reason for rejecting claims 2 and 3 under § 112, second paragraph. In this manner, the second paragraph of 35 U.S.C. § 112 is directed to fulfilling two separate requirements: 1. the claims must set forth the subject matter regarded as the invention; and 2. the claims must particularly point out and distinctly define the invention. M.P.E.P. § 2171. The Examiner does not set forth any reasons why either claim 2 or 3 fails to satisfy either one of these requirements. As such, the Examiner has not set forth a proper basis for sustaining the § 112, second paragraph rejections of claims 2 and 3.

Thus, for at least these reasons, the § 112, second paragraph rejections of claims 2 and 3 are improper and should be reversed.

**I. Can claims 31 and 33 be indefinite when these claims satisfy the requirements of 35 U.S.C. § 112, second paragraph?**

Claim 31 depends from claim 30 and recites that the body of claim 30 is adapted to at least partially extend over a lens socket of the eyeglass frames. Claim 33 also depends from claim 30 and recites that the fastener(s) includes a first fastener to attach the eye patch to a bridge of the eyeglass frames and a second fastener to attach the eye patch to a side arm of the eyeglass frames.

The Examiner rejects claims 31 and 33 under 35 U.S.C. § 112, second paragraph. However, the Examiner fails to set forth why the claims do not 1. set forth the subject matter regarded as the invention; or 2. particularly point out and distinctly define the invention. M.P.E.P. § 2171. Without such a showing, the Examiner has failed to establish a proper basis for any of these § 112, second paragraph rejections.

Thus, the § 112, second paragraph rejections of claims 31 and 33 are improper and should be reversed.

## IX. CONCLUSION

Applicant requests that each of the final rejections be reversed and that the claims subject to this appeal be allowed to issue.

Respectfully submitted,

Date: May 5, 2003

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# APPENDIX OF CLAIMS

The claims on appeal are the following:

1. An eye patch usable with eyeglass frames that comprises a bridge and a side arm, the eye patch comprising:

a flexible body to be positioned on a front of the frames to substantially block both frontal and peripheral vision of an eye;

a first fastener to attach the body to the bridge; and

a second fastener to attach the body to the side arm.

2. The eye patch of claim 1, wherein

the body is adapted to at least partially extend over a lens socket of the eyeglass frames.

3. The eye patch of claim 1, wherein

the body is adapted to at least partially extend over a lens of the eyeglass frames.

4. The eye patch of claim 1, wherein

the body is adapted to at least partially extend along the side arm.

5. The eye patch of claim 1, wherein the first fastener comprises a loop comprising a first end secured to the body and a second end adapted to extend around the bridge to releasably couple the bridge to the body.

6. The eye patch of claim 5, wherein the first fastener further comprises:

a releasable connector adapted to releasably couple the side arm to the body.

7. The eye patch of claim 5, wherein

the body includes at least one slot, and

the second end comprises a pronged tab adapted to be inserted into the slot to releasably couple the second end to the body.

8. The eye patch of claim 1, wherein the second fastener comprises at least one slit formed in the body to receive the arm.

9. The eye patch of claim 1, wherein the second fastener comprises:

a loop adapted to extend around the side arm, the loop having a first end secured to the body and a second end.

10. The eye patch of claim 9, wherein the second end is adapted to releasably couple the loop to the body.

11. The eye patch of claim 9, wherein the second end is secured to the body.

12. The eye patch of claim 1, wherein the body comprises a fabric selected from a set consisting essentially of: fabric and foam.

13. The eye patch of claim 1, wherein the body comprises a pliable material.

14. The eye patch of claim 1, wherein the first fastener is adapted to attach the body to the bridge regardless of whether the eye comprises a left eye or a right eye.

15. The eye patch of claim 1, wherein the second fastener is adapted to attach the body to the arm regardless of whether the eye comprises a left eye or a right eye.

16. An assembly comprising:

eyeglass frames comprising a bridge and a side arm; and

an eye patch comprising:

a flexible body to be positioned on a front of the frames to substantially block both frontal and peripheral vision of an eye;

a first fastener to attach the body to the bridge of the eyeglass frames; and

a second fastener to attach the body to the arm of the eyeglass frames.

17. The assembly of claim 16, wherein

the eyeglass frames comprises a lens socket, and

the body is adapted to at least partially extend over the lens socket.

18. The assembly of claim 16, wherein

the body is adapted to at least partially extend along the side arm.

19. The assembly of claim 16, wherein the first fastener comprises a loop comprising a first end secured to the body and a second end adapted to extend around the bridge to releasably couple the bridge to the body.

20. The assembly of claim 19, wherein the first fastener further comprises:

a releasable connector adapted to releasably couple the side arm to the body.

21. The assembly of claim 19, wherein

the body includes at least one slot, and

the second end comprises a pronged tab adapted to be inserted into the slot to releasably couple the second end to the body.

22. The assembly of claim 16, wherein the second fastener comprises at least one slot formed in the body to receive the side arm.

23. The assembly of claim 16, wherein the second fastener comprises:

a loop adapted to extend around the side arm, the loop having a first end secured to the body and a second end.

24. The assembly of claim 23, wherein the second end is adapted to releasably couple the loop to the body.

25. The assembly of claim 23, wherein the second end is secured to the body.

26. The assembly of claim 16, wherein the body comprises a fabric selected from a set consisting essentially of: fabric and foam.

27. The assembly of claim 16, wherein the body comprises a fabric selected from a pliable material.

28. The assembly claim 16, wherein the first fastener is adapted to attach the body to the bridge regardless of whether the eye comprises a left eye or a right eye.

29. The assembly of claim 16, wherein the second fastener is adapted to attach the body to the side arm regardless of whether the eye comprises a left eye or a right eye.

30. An eye patch usable with eyeglass frames, comprising:

a flexible body to be fastened to at least partially cover a front of the eyeglass frames to substantially block both frontal and peripheral vision of an eye; and

at least one fastener to secure the flexible body to the frames.

31. The eye patch of claim 30, wherein

the body is adapted to at least partially extend over a lens socket of the eyeglass frames.

32. The eye patch of claim 30, wherein

the body is adapted to at least partially extend along a side arm of the frames.

33. The eye patch of claim 30, wherein

at least one fastener comprises:

a first fastener to attach the eye patch to a bridge of the eyeglass frames; and

a second fastener to attach the eye patch to a side arm of the eyeglass frames.

34. An assembly comprising:

eyeglass frames; and

an eye patch comprising:

a flexible body to be fastened to at least partially cover a front of the eyeglass frames to substantially block both frontal and peripheral vision of an eye; and

at least one fastener to secure the flexible body to the frames.

35. The assembly of claim 34, wherein

the eyeglass frames comprises a lens socket, and

the body is adapted to at least partially extend over the lens socket.

36. The assembly of claim 34, wherein

the eyeglass frames holds a lens, and

the body is adapted to at least partially extend over the lens.

37. The assembly of claim 34, wherein

the body is adapted to at least partially extend along a side arm of the frames.

38. The assembly of claim 34, wherein

the eyeglass frames comprise a side arm and a bridge, and

said at least one fastener comprises:

a first fastener to attach the eye patch to the bridge; and

a second fastener to attach the eye patch to the side arm.

39. An eye patch usable with eyeglass frames that comprises a bridge, the eye patch comprising:

a flexible body to be positioned on a front of the frames to substantially block both frontal and peripheral vision of an eye; and

a fastener extending from the body to attach the body to the bridge.

40. The eye patch of claim 39, wherein

the body is adapted to at least partially extend along a side arm of the frames.

41. The eye patch of claim 39, wherein the flexible body is not positioned on a rear of the frames.

42. The eye patch of claim 39, wherein the fastener comprises a tab separate from the body to secure the body of the bridge of the frame.

43. The eye patch of claim 39, wherein the fastener comprises a loop comprising a first end secured to the body and a second end adapted to extend around the bridge to releasably couple the bridge to the body.

44. The eye patch of claim 39, wherein the fastener comprises a releasable connector adapted to releasably couple the bridge to the body.

45. The eye patch of claim 39, wherein

the body includes at least one slot, and

the second end comprises a pronged tab adapted to be inserted into the slot to releasably couple the second end to the body.

46. An eye patch usable with eyeglass frames that comprises a bridge and a side arm, the eye patch comprising:

a flexible body comprising a first portion positioned on a front of the frames to substantially block frontal vision of an eye and a second portion attached to the first portion to substantially block peripheral vision of the eye;

a first fastener to attach the body to the bridge; and

a second fastener to attach the body to the side arm.

47. The eye patch of claim 46, wherein

the first and second portions are substantially opaque.

48. The eye patch of claim 46, wherein

the second portion is adapted to at least partially extend along the side arm.

49. The eye patch of claim 46, wherein the first fastener comprises a loop comprising a first end secured to the body and a second end adapted to extend around the bridge to releasably couple the bridge to the body.

50. The eye patch of claim 49, wherein the first fastener further comprises:

a releasable connector adapted to releasably couple the side arm to the body.

51. The eye patch of claim 46, wherein the second fastener comprises:

a loop adapted to extend around the side arm, the loop having a first end secured to the body and a second end.

52. A method comprising:

providing a flexible body to attach to a front of eyeglass frames to substantially block both frontal and peripheral vision of an eye;

providing a first fastener to attach the body to a bridge of the eyeglass frames; and

providing a second fastener to attach the body to a side arm of the eyeglass frames.

53. The method of claim 52, further comprising:

forming the body to at least partially extend along the side arm of the eyeglass frames.

54. The method of claim 52, further comprising:

selecting a material for the flexible body, wherein the material is substantially opaque.

55. The method of claim 52, further comprising:

extending a loop around the bridge to attach the body to the bridge.

56. The method of claim 52, further comprising:

extending a loop around the side arm to attach the body to the side arm.